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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,967	04/02/2004	Werner Holzl	HM/5-22028/A/CONT 2	1686

7590 12/02/2005

Ciba Specialty Chemicals Corporation
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EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/816,967

Applicant(s)

HOLZL ET AL.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-33 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-32 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 33 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 22-33 and 37 are pending.

Claims 22-32 are allowed.

Claims 33 and 37 are objected.

Claims 1-21, 34-36 and 38 are cancelled.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 6, 2005 has been entered.

Double Patenting

3. Claim 33 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 23. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

4. Claim 37 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 24. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim

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to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Response to Amendment and Arguments filed September 6, 2005


5. The rejection of claims 22-33, and 37 under 35 U.S.C. 103(a) as being unpatentable over Muntwyler et al. (US 4,268,693) in view of Silverman (The Organic Chemistry of Drug Design and Drug Action, 1992, pages 15-19, in particular Table 2.2 on page 19) is withdrawn since there are now multiple structural differences between the instant compounds and those of Muntwyler et al. in view of Silverman and one of ordinary skill in the art would not have been motivated to make such multiple changes.
6. The rejection of claims 22, 23, 33, and 37 under 35 U.S.C. 103(a) as being unpatentable over Troesken et al. (DE 2538016 A1) is withdrawn since there are now multiple structural differences between the instant compounds and those of Troesken et al. and one of ordinary skill in the art would not have been motivated to make such multiple changes.
7. The rejection of claims 22, 23, and 33 under 35 U.S.C. 103(a) as being unpatentable over Fujikawa et al. (Yakugaku Zasshi, Vol. 91(9), pp. 930-933, 1971) is withdrawn since there are now multiple structural differences between the instant compounds and those of Fujikawa et al. and one of ordinary skill in the art would not have been motivated to make such multiple changes.
8. The rejection of claims 22-25, 27, 30-33 and 37 under 35 U.S.C. 103(a) as being unpatentable over Leichlingen et al. (US 3,753,914) is withdrawn since there are now multiple structural differences between the instant compounds and those of Leichlingen et al. and one of ordinary skill in the art would not have been motivated to make such multiple changes.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalyn Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M and F 3:00-8:00 pm and T-TR 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Rosalyn Keys
Primary Examiner
Art Unit 1621

November 27, 2005